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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,347	12/29/2000	William D. Rupp	3660P019X3	8394

7590 11/29/2006  
Lester J. Vincent  
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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3693

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/753,347

Applicant(s)

RUPP ET AL.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 11, 12 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11-12 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/14/06</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to amendment filed 9/14/2006.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/14/2006 has been entered.

#### ***Response to Amendment***

3. Claims 1, 3, 11 and 15 have been amended. Claims 1-5, 11-12 and 15 remain pending and have been examined.

#### ***Response to Arguments***

4. Applicant's arguments with respect to rejection of claims over have been considered but are moot in view of the new ground(s) of rejections.

#### ***Claim Rejections - 35 USC § 101***

#### **35 USC 101 Rejection**

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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5, 11-12 and 15 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are analyzed to determine whether the invention produces a useful, concrete, and tangible result.

Exemplary claim 1 is analyzed.

Claim 1 only recites setting the bid adjustment mechanism to a bid adjustment value without further stating the effect of this step. There is no bid adjustment taking place as a result of the setting. Even if the bid adjustment takes place it could be interpreted as mere data gathering step and renders the claim as being directed to a non-statutory process.

If the only limitations in the claims in addition to the mathematical algorithm are data-gathering steps which "merely determine values for the variables used in the mathematical formulae used in making the calculations." Such antecedent steps are insufficient to change a nonstatutory method of calculation into a statutory process. See *In re Richman*, 563 F.2d at 1030. 195 USPQ at 343; *Sarkar*, 588 F.2d at 1335. 200 USPQ at 139 ("If the steps of gathering and substituting values were alone sufficient, every mathematical equation, formula, or algorithm having any practical use would be per se subject to patenting as a 'process' under §101"): *Gelnovatch*, 595 F.2d at 41 n.7. 201 USPQ at 145 n.7 ("claimed step of perturbing the values of a set of process inputs (step 3), in addition to being a mathematical operation, appears to be a data-gathering step"). Where the claim "presents data gathering steps not dictated by the algorithm but by other limitations which require certain antecedent steps" the claim may present statutory subject matter. *Abele*, 684 F.2d at 908, 214 USPQ at 687.

***Claim Rejections - 35 USC § 102***

5. Claims 1, 11 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Dinwoodie (US Pat. 7076460) (hereafter referred to as Dinwoodie).

Per claim 1, Dinwoodie teaches a method of configuring a bid adjustment mechanism in an online auction, (bidder and auctioneer interfaces, p.12) comprising the steps of:

(a) displaying a bid adjustment mechanism configuration interface including the bid adjustment mechanism that allows a bidder to specify an adjustment for a bid without entering an amount of the bid ( Fig. 1 Auction site 14 which initializes and displays a bid adjustment mechanism (interpreted as the entire set of parameters and which allows the bidder to adjust the bid via setting a bid adjustment using a predefined increment, see col. 5 L 33-58 and col. 3 and 4 ) and

(b) setting the bid adjustment mechanism to a bid adjustment value specified by the bidder using the configuration interface such that when the bid adjustment mechanism is actuated, a bid is adjusted by the bid adjustment value set in the configuration interface.

( col. 5 L 33-58, the auction site is set to a predefined bid increment, ).

Note that claims 11 and 15 are apparatus claims that correspond to method claim 1 and accordingly analyzed in the foregoing analysis.

The examiner points out that although the prior art of Dinwoodie teaches that the bid is adjusted by the bid adjustment value upon actuation of the adjustment mechanism this portion of the limitation (such that ..) recites the aforementioned limitation only in terms of intended use. In order to accord patentable weight this intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably

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distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Since this is not the case the intended use limitation is not considered for patentability.

***Claim Rejections - 35 USC § 103***

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dinwoodie.

Dinwoodie fails to teach that the bid adjustment mechanism is a button on a graphical user interface displayed to the bidder.

Official Notice is taken that displaying information for adjustment using a button on a graphical user interface is old and well known.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to select a specific type of adjustment mechanism, which is suitable for the specific application, which would facilitate quick data entry.

7. Claims 3-5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dinwoodie as analyzed in claims 1 and 2 and further in view of Fisher.

Dinwoodie fails to teach that the bid adjustment value comprises selecting a bid adjustment type associated with the bid adjustment value as recited in claims 3-5 and 12.

Fisher, in the same field of endeavor, however, teaches a bid adjustment type associated with the bid adjustment value which corresponds to an absolute value or a percentage of a

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previous bid (see col. 12 L 33+, bidding increment amount and percentage, noting that the increment amount is in Dollar amount).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Dinwoodie in view of Fisher wherein a feature of bid adjustment type associated with the bid adjustment value is provided which corresponds to an absolute value or a percentage of a previous bidder because such an improvement would provide greater flexibility and convenience to the proxy bidder in adjusting bid for a wide range of bid values.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on **800AM-630PM Mon-Tue and Thu.**

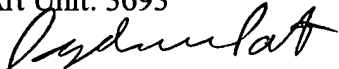
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammel can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jagdish N. Patel

(Primary Examiner, AU 3693)

11/27/06